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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,244	12/19/2000	Elizabeth Goldwyn Gibson	1906P	8208

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SAWYER LAW GROUP LLP
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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,244

Applicant(s)

GIBSON ET AL.

TM

Examiner

Md S Elahee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Applicant's admitted prior art.

Regarding claim 1, Applicant discloses on page.1 that a telephone system has a switching system for receiving a call from a calling party.

Applicant further discloses on page.1 that a telephone system has a voice mail box coupled to the switching system for receiving the call if a called party does not pick up the phone ('pick up the phone' reads on the claim 'answer the call').

Applicant further discloses on page.1 and page.2 that a telephone system has a telephone for receiving the call from the calling party, the telephone being capable of screening the calling party when the calling party is coupled to the voice mailbox.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Muller (U.S. Patent No. 6,295,341).

Regarding claims 2 and 12, Applicant discloses on page.1 that the telephone further includes first and second connections to the switching system. However, Applicant's admitted prior art fails to specifically disclose "wherein in one of the first and second connections is utilized to provide a three-way call between the calling party, the called party and the voice mailbox". Muller teaches providing a three-way calling service between the caller, the user and the Remote Answering Device (abstract; col.4, lines 5-25; 'three-way calling service' reads on the claim 'three-way call', 'caller' reads on the claim 'calling party', 'user' reads on the claim 'called party' and 'Remote Answering Device' reads on the claim 'voice mail box'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow three-way call feature as taught by Muller. The motivation for the modification is to have the three-way call feature to allow a phone user to add another user to an existing conversation and have a three party conference call.

Regarding claims 3 and 13, Applicant's admitted prior art fails to specifically disclose "the three-way called party can not hear the calling party during the three-way call". Muller teaches the three-way user inherently can not hear the caller during the three-way calling service (abstract; col.4, lines 5-25; 'user' reads on the claim 'called party', 'caller' reads on the claim 'calling party' and 'three-way calling service' reads on the claim 'three-way call'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow the three-way called party not to hear the calling

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party as taught by Muller. The motivation for the modification is to have the three-way call feature not to allow another user to hear an existing conversation with the calling party during the three-way call.

Regarding claims 4 and 14, Applicant's admitted prior art further fails to teach "the called party can through interaction with the telephone talk with the calling party through the other of the first and second connections and the voice mail box is dropped from the call". Muller further teaches that the user can talk normally with the caller inherently through the other of the first and second connections and the Remote Answering Device is dropped from the call (abstract; col.4, lines 5-36; 'talk normally' reads on the claim 'through interaction with the telephone talk', 'user' reads on the claim 'called party', 'caller' reads on the claim 'calling party' and 'Remote Answering Device' reads on the claim 'voice mail box'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow the called party talking normally with the caller as taught by Muller. The motivation for the modification is to drop the voice mail box so that the conversation can take part between the calling party and the called party.

Regarding claims 5 and 8, Applicant's admitted prior art further discloses on page.1 and page.2 receiving a call from a calling party by a voice mail box.

Applicant's admitted prior art further discloses on page.1 and page.2 that the called party can screen the calling party's message. However, Applicant's admitted prior art further fails to teach "joining the called party, calling party and voice mailbox in a three-way call via a connection from a telephone of the called party". Muller teaches joining the user, caller and Remote Answering Device in a three-way calling service inherently via a connection from a

telephone of the user (abstract; col.4, lines 5-25; 'user' reads on the claim 'called party', 'caller' reads on the claim 'calling party', 'Remote Answering Device' reads on the claim 'voice mail box' and 'three-way calling service' reads on the claim 'three-way call'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow three-way call feature as taught by Muller. The motivation for the modification is to have the three-way call feature to allow a phone user to add another user to an existing conversation and have a three party conference call.

Regarding claims 6 and 9, Applicant's admitted prior art further fails to specifically disclose "preventing the calling party from hearing the called party, calling party and voice mailbox". Muller teaches preventing the caller inherently from hearing the user, caller and voice mailbox (abstract; col.4, lines 5-25; 'caller' reads on the claim 'calling party', 'user' reads on the claim 'called party' and 'Remote Answering Device' reads on the claim 'voice mail box'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow the three-way called party not to hear the called party, calling party and voice mailbox as taught by Muller. The motivation for the modification is to have the three-way call feature to prevent the calling party from hearing the called party, calling party and voice mailbox during the three-way call.

Regarding claims 7 and 10, Applicant's admitted prior art further fails to teach "dropping the voice mail box from the three-way call by the telephone when the calling party speaks to the called party". Muller further teaches dropping the Remote Answering Device from the three-way calling service when the caller talks to the user (abstract; col.4, lines 5-36; 'Remote Answering Device' reads on the claim 'voice mail box', 'three-way calling service' reads on the claim

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'three-way call by the telephone', 'caller' reads on the claim 'calling party', 'talks' reads on the claim 'speaks' and 'user' reads on the claim 'called party'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to allow the called party talking normally with the caller as taught by Muller. The motivation for the modification is to drop the voice mail box so that the conversation can take part between the calling party and the called party.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Dee et al. (U.S. Patent No. 6,115,602).

Regarding claim 11, Applicant's admitted prior art further discloses on page.1 and page.2 a receiver for receiving a call from the calling party.

Applicant's admitted prior art further further fails to teach "a voice mail screening system within the telephone for allowing a called party of hearing the calling party when the calling party is coupled to a voice mailbox". Dee teaches a call screening system within the telephone for allowing a called party of hearing the calling party when the calling party is coupled to a voice mailbox (abstract; col.1, lines 56-68, col.2, lines 39-62; 'call' reads on the claim 'voice mail'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Applicant's admitted prior to have the call screening system within the telephone as taught by Dee. The motivation for the modification is to have the call screening system within the telephone in order to assist the called party to screen the incoming calls from the calling party so that he can make a selection of the calls to hear.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703)305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

M. E.
MD SHAFIUL ALAM ELAHEE
December 29, 2002

KAW Williams
Kimberly A. Williams
Primary Examiner
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